

REMARKS

Claims 15 through 27 are under examination in this application. Claims 15 through 27 were rejected in the Final Office Action dated July 25, 2008. Applicants filed a response After Final on October 13, 2008. Applicant then received an Advisory Action dated November 19, 2008. In the Response After Final, Applicants traversed the Office's written description rejection based on the phrase "inhibiting PMN infiltration" by amending the claim to recite "inhibiting PMN migration across columnar epithelia" for which there is ample and specific support in the as-filed specification. In the Advisory Action, the Office's reasons for non-allowance are stated as "of reasons of record." Because there can be no record for such reasons, the terminology being newly entered into the claims in the response of October 13, 2008, Applicants must conclude that the rejection is in error because it cannot fulfill the requirements of the MPEP 2163.05 which states:

Upon reply by applicant, before repeating any rejection under 35U.S.C. 112, para. 1, for lack of written description, review the basis for the rejection in view of the record as a whole, including amendments, arguments and any evidence submitted by applicants. If the whole record now demonstrates that the written description requirement is satisfied, do not repeat the rejection in the next Office action. If the record still does not demonstrate that the written description is adequate to support the claim(s), repeat the rejection under 35 U.S.C. 112, para. 1, fully respond to applicant's rebuttal arguments, and properly treat any further showings submitted by applicant in the reply. When a rejection is maintained, any affidavits relevant to the 35. U.S.C. 112, para.1, written description requirement, must be thoroughly analyzed and discussed in the next Office action. See *In re Alton*, 76 F.3d 1168, 1176, 37 USPQ2d 1578, 1584 (Fed. Cir. 1996).

Thus, because the Advisory Action indicates that the amendments were entered, and because there is no evidence that any of the requirements of the above quoted MPEP were followed, Applicants respectfully submit that the rejection is in error and the claims should be passed to allowance. However, for the purposes of providing a complete record, Applicants are hereby recapitulating the argument traversing the rejection set out in the final Office Action of July 25, 2008. Reconsideration or the rejections and passage to allowance of claims 15-27 is now respectfully requested.

Rejection of Claims 15 through 27 under 35 U.S.C. § 112

Claims 15 through 27 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office states that the specification fails to provide support for the phrase “inhibiting PMN infiltration.”

This rejection is overcome, at least, for the following reasons.

The claim has been amended herein to recite that the invention comprises a method of “inhibiting PMN migration across columnar epithelia.” Explicit support for this amendment is found throughout the as-filed application at, for example, paragraphs [003], [006]-[0009], [0012]-[0022], and EXAMPLE 1 at [0075]-[0124], to name a few. Thus, Applicants submit that the specification includes a written description of inhibiting PMN migration across columnar epithelia. The rejection is therefore overcome and should be withdrawn. Applicants respectfully request same.

The Office states that the claims, in their broadest reasonable interpretation, read on a pharmaceutical composition comprising any analog of natural lipoxin A4. Thus, the Office asserts that “[W]hile the specification describes a few species of the instantly claimed active compounds, it does not describe a sufficient number of analogs as to convey possession of the entire genera encompassed by the instant claims.

This rejection is overcome, at least, for the following reasons.

In its rejection, the Office states “[T]o provide adequate written description and evidence of possession of the claimed genus, the specification must provide sufficient distinguishing identifying characteristics of the genus. The factors to be considered include (1) disclosure of complete or partial structure, (2) physical and/or chemical properties, (3) functional characteristics, (4) structure/function correlation or any combination thereof.”

Applicants respectfully submit that examples of each of these factors are explicitly recited in the specification. Specifically, taken in turn, the Office is referred to: (1) the structures enumerated in paragraphs [0047] and [0048] of the published application and as-filed claims 16-26. In addition, the specification provides a discussion lipoxin analogs and salient characteristics

thereof in paragraphs [0039]-[0046]; (2) with regard to physical and/or chemical properties, the Office is again directed to paragraphs [0039]-[0046], describing particular physical and chemical properties as well as EXAMPLE 3 spanning paragraphs [0153]-[183], which provides methods for synthesizing some lipoxin compounds; (3) functional characteristics of lipoxins are described throughout the specification and, in particular, the effect that lipoxins have in inhibiting PMN migration across epithelia. In addition, methods of using lipoxins for treatment are provided starting, at least, at paragraph [0059]. In addition, the specification provides methods for screening for lipoxins at, for example, paragraphs [0032]-[0038]; and (4) with regard to structure/function correlations, the specification discusses such factors throughout the specification as well. Specifically, the Office is directed to the specification at, for example, the summary beginning at paragraph [0006], the detailed description beginning at paragraph [0010], the EXAMPLES, etc. In particular, the Office's attention is directed to the section beginning at paragraph [0039], which describes the structure/function correlation of lipoxin compounds. Further, with specific regard to the structure and function of lipoxins on columnar epithelia, the Office's attention is directed to EXAMPLE 4 beginning at paragraph [0184]. Thus, Applicants submit that all the factors required by the Office to illustrate possession of the genus are, in fact, described in the written description detail. Therefore, the rejection is overcome and should be withdrawn. Applicants respectfully request same.

CONCLUSION

In light of the above, it is respectfully submitted that the present application is in condition for allowance. Reconsideration of the present application and a favorable response are respectfully requested. If a telephone conference would be helpful in resolving any remaining issues, please contact the undersigned at (612) 492-6864.

This response is being submitted on or before December 25, 2008, with the required fee of \$490.00 for a two-month extension of time, making this a timely response. It is believed that no additional fees are due in connection with this filing. However, the Commissioner is authorized to charge any additional fees, including extension fees or other relief which may be required, or credit any overpayment and notify us of same, to Deposit Account No. 04-1420.

Respectfully submitted,

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